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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/804,034      | 03/19/2004  | Paul Lapstun         | NPA136US            | 7056             |

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

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| EXAMINER |
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PHAM, THIERRY L

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| ART UNIT | PAPER NUMBER |
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2625

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 03/22/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/804,034             |  | LAPSTUN ET AL.      |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Thierry L. Pham        |  | 2625                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/20/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 3/1/07.
- Claims 1-9 are currently pending.
- IDS filed 12/20/06 has been considered and herein attached (PTO 1449) with Office Action.

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/06 has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1:

- (•) a scanner for scanning a document containing document data, first coded data indicative of an identity of the document and user input – it is unclear whether document data, coded data, and user input are scanning at the same time or different moment in time. The examiner herein interprets document data, coded data, and user input are scanned at different time frame.
- (•) a detector for detecting said scanned first coded data for accessing a digital version of the document and said scanned user input to determine a user request – it is unclear

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whether scanned coded data and scanned user input are detected at the same time or different moment in time. The examiner herein interprets scanned coded data and scanned user input are detected at different time frame.

(●) and for incorporating in said printed copy document content in accordance with said user request and second coded data indicative of an identity of the copy – it is unclear what content are incorporated in a printed copy. Is it second coded data? User input? Clarification is herein required. The examiner herein interprets second coded data is being incorporated into printed copy.

Claims 2-9 are rejected based upon their dependency.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (US 6137590), and in view of Lopresti et al (US 5754308).

Regarding claim 1, Mori discloses a copier (fig. 3) including:

- a scanner (different types of scanners can be used, col. 4, lines 25-35 and col. 5, lines 40-45) for scanning a document containing document content (document 10, fig. 7), first coded (coded data 10a, fig. 7) data indicative of an identity of the document and user input (user's input, col. 8, lines 25-37);
- a detector (bar-code reader of identification code read section 8, fig. 6, col. 5, lines 4-62) for detecting said scanned first coded data (coded data 10a, fig. 7) for accessing a digital version of the document (accessing and retrieving digital version of the document, fig. 7, col. 7, lines 1-10) and said scanned user input to determine a user request (col. 8, lines 25-37); and
- a printer (printing section 5, fig. 6) adapted for printing a retrieved digital version of the document (retrieved copy is printed via printing section 5, col. 7, lines 1-10) and to

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incorporate a second coded data indicative of an identity of the copy (via using second identification code assignment section 9, fig. 22, col. 13, lines 10-54).

Mori teaches an image forming apparatus for scanning, retrieving, and printing digital version of the document via detecting/sensing coded data 10a on printed document 10, but explicitly fails to teach and/or suggest a printer adapted for printing a copy of the digital version of the "scanned" document and to incorporate a second coded data identity of an identity of the copy in accordance with user request.

Lopresti, in the same field of endeavor for an image forming apparatus, teaches a well-known example of a copier (fig. 3) having a printer adapted for printing a copy of the digital version of the "scanned" document and to incorporate a second coded data identity of an identity of the copy (printing/copying a "scanned" document along with newly DocID, col. 7, lines 35 to col. 8, lines 13) in accordance with user request (fig. 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify image forming apparatus of Mori to include a printer engine for printing a copy of the digital version of the "scanned" document and to incorporate a second coded data identity of an identity of the copy as taught by Lopresti because of a following reason: (●) to obtain a high quality reproductions of document by scanning and utilizing reproduction information encoded in the inventive indicia provided on the printed document (col. 2, lines 8-13 of Lopresti); (●) to retrieve and reproduce subsequent originals of printed document quickly and conveniently via using encoded DocIDs (col. 2, lines 15-22).

Therefore, it would have been obvious to combine Mori with Lopresti to obtain the invention as specified in claim 1.

Regarding claim 2, Mori further discloses a copier according to claim 1 further including a network interface (I/F 2, fig. 1, col. 3, lines 25-28 and col. 4, lines 40-60) for transmitting to a computer system data indicative of said first coded data and for receiving from said computer system response data (fig. 15) indicative of an identity of the copy.

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Regarding claim 3, Mori further discloses a copier according to claim 2 further including a coded data generator (identification code assignment section 7, fig. 6) adapted to generate said second coded data from said response data.

Regarding claim 4, Mori further discloses a copier according to claim 1 wherein said copier is adapted to communicate (I/F 2, fig. 1, col. 10, lines 45-55) with a server (col. 4, lines 60-63) for allocating a unique identifier to each copy.

Regarding claim 5, Mori further discloses a copier according to claim 4 wherein data indicative of said unique identifier is incorporated into said second coded data (barcode 10a, fig. 7) and is printed in said printed copy.

Regarding claim 7, Mori further discloses a copier according to claim 2 further adapted to transmit through said network interface (I/F 2, fig. 1) second document data representing said copy of the document to enable said second document data to be stored.

Regarding claim 8, Mori further discloses a copier according to claim 7 wherein said second document data can be retrieved (retrieving digital copy via scanning barcode 10a, fig. 7) through said network interface to enable reproduction of said copy with both document content and coded data.

Regarding claim 9, Lopresti further discloses a copier according to claim 1, wherein the printer is further adapted to incorporate (printing/copying a "scanned" document along with newly DocID, col. 7, lines 35 to col. 8, line 13) in said printed copy portions of said document content as scanned by the scanner not contained (newly DocID not previously in digital version of document, col. 7, lines 35 to col. 8, line 13) in said digital version of the document in accordance with said user request (user request, fig. 5) determined from the scanned user input.

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Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori and Lopresti as described in claim 1 above, and in view of Dymetman et al (US 6330976).

Regarding claim 6, combinations of Mori and Lopresti disclose a second coded data indicative of an identity of the copy, but fail to teach and/or suggest wherein a second coded data device is indicative of a plurality of reference points on a printed copy to identify the position of the sensing device relative to the copy.

Dymetman, in the same field of endeavor for printing, teaches a second coded data indicative of an identity of the copy, but fails to teach and/or suggest wherein a second coded data device (col. 3, lines 50-67 and col. 9, lines 15-21) is indicative of a plurality of reference points on a printed copy to identify the position (location identifier coded data for identifying location of a photograph, zone, and etc within a document, col. 3, lines 58-67 and col. 8, lines 60-67) of the sensing device relative to the copy.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Mori and Lopresti inventions to include coded data identifying a position of the sensing device relative to the copy as taught by Dymetman because of a following reason: (●) the bar reader not only reads embedded coded data, but also determines the exact location/position of its pointer; by doing so, it ensures the users that the right coded data is read; (●) adding a location identifier coded data to identify the position of the sensing device relative to the copy helps user to easily locate the location of the tags.

Therefore, it would have been obvious to combine Mori and Lopresti with Dymetman to obtain the invention as specified in claim 6.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection in view of different interpretations of previous applied art due to newly added feature.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



GABRIEL Y. GARCIA  
PRIMARY EXAMINER